

ADMINISTRATIVE PANEL DECISION

Yingli Green Energy Australia Pty Ltd
-v-
The 12 Volt Shop

Case No. LEADR-auDRP 14/03

Domain Name: yingli.com.au
Complainant: Yingli Green Energy Australia Pty Ltd
Respondent: The 12 Volt Shop
Provider: LEADR
Panelist: Sara Delpopolo

1. THE PARTIES

- (a) The complainant is Yingli Green Energy Australia Pty Ltd (ACN 159 202 132) of Unit 51, Upper Wharf, Jones Bay Wharf, 26-32 Pirrama Road Pyrmont, New South Wales 2009 (**Complainant**).
- (b) The respondent is Sueton Trust trading as The Twelve Volt Shop (ABN 76 159 775 602) of PO Box 82 Welshpool, Western Australia 6106 (**Respondent**).

2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name is <yingli.com.au> (**Domain Name**). The registrar is AussieHQ (**Registrar**).

3. PROCEDURAL HISTORY

- (a) The complaint was submitted for mediation in accordance with the .au Dispute Resolution Policy (**auDRP**), the auDA Rules for .au Dispute Resolution Policy and the LEADR Supplemental Rules for .au Domain Name Dispute Resolution Policy.
- (b) The complete application was received from the Complainant by LEADR on 9 April 2014.
- (c) A copy of the complaint was submitted, and a request to clarify the Respondent's details and lock the domain name was emailed to the Registrar on 9 April 2014.
- (d) On 9 April 2014, the Registrar confirmed via email that the domain name in dispute had been locked.
- (e) LEADR advised auDA of the complaint on 11 April 2014 via email.
- (f) On 14 April 2014, LEADR sent the Respondent a dispute notification letter and a copy of the complaint was submitted by post and email.

- (g) On 4 May 2014, the Respondent submitted a response to the domain name complaint.
- (h) On 6 May 2014, LEADR received further submissions from the Complainant.
- (i) The Panellist was appointed on 15 May 2014.

4. FACTUAL BACKGROUND

4.1 Facts Alleged by Complainant

The Complainant is Yingli Green Energy Australia Pty Ltd (ACN 159 202 132). The Complainant stated that it brings this complaint on behalf of its related company, Yingli Green Energy Holdings Co., Ltd.

The Complainant alleges that the Domain Name is identical to the Australian Registered Trade Mark Nos. 1278609 “YINGLI SOLAR LOGO” and 1576255 “YINGLI” which is owned by Yingli Energy (China) Co., Ltd which forms part of the Yingli Group.

The Complainant approached the Respondent in July 2013 to purchase the Domain Name but no agreement was reached between the parties.

The Complainant claims that the Domain Name was unused until the Complainant approached the Respondent in July 2013, after which the Respondent populated the Domain Name with content and commenced reselling the Yingli products in Australia via its now active website.

The Complainant submitted evidence of an invoice issued by Yingli Energy (Beijing) Co., Ltd (which is a member of the Yingli Group) to Arrid Australia dated 27 July 2010. The Complainant alleges that Arrid Australia is associated with the Respondent as they share the same address.

The Complainant refers to the Respondent’s representation of “The 12 Volt Shop Trading as Yingli” on the website <www.yingli.com.au> and claimed that it constitutes a breach of Registered Trade Mark No. 1576255 as the Respondent was never authorised by the Yingli Group to use the trade mark “YINGLI”.

In the Complainant’s view, the Domain Name is identical to the Trade Mark Nos. 1278609 and 1576255; the Respondent has no rights or legitimate interests in the respect of the Domain Name as it only resells the Yingli products; and the Respondent registered and subsequently used the Domain Name in bad faith.

The Complainant therefore seeks to have the Domain Name transferred to its related company, Yingli Energy (China) Co., Ltd which is the owner of the Australian Registered Trade Mark Nos. 1278609 and 1576255.

4.2 Facts Alleged by the Respondent

Ms Susan Godfrey, who is authorised to act for the Respondent in this proceeding, submitted a response to the complaint within the time required under the auDRP.

The Respondent submitted copies of emails exchanged between Ms Godfrey and Mr Daman Cole, Managing Director of the Complainant in relation to the sale of the Domain Name between September and October 2013. From the email chain, the Respondent agreed to sell the Domain Name to the Complainant for the payment of \$4,000. However, due to disagreement about the method of payment, the sale did not actually happen.

The Respondent states that it commenced trading as “The Twelve Volt Shop” in the solar industry in 1993, and later started another company called “Arrid” as a wholesaler of solar modules. The Respondent submitted that since mid-2010 it has imported USD\$500,000 of solar modules to date from Yingli Energy (Beijing) Co., Ltd, and that it has had an amicable business relationship with this company.

The Respondent previously sold other manufacturers’ solar modules such as Uni-Solar and BP in addition to the Yingli solar module, but it decided to concentrate on the Yingli branded products. The Respondent therefore decided to register the Domain Name hoping to become the Australian distributor for the Yingli solar modules.

The Respondent admits that the Domain Name was initially used to direct traffic to its website <www.12volt.com.au> but later decided to set up a new website at <www.yingli.com.au> where the Yingli solar modules were the only modules being sold.

In relation to its use of “The 12 Volt Shop Trading as Yingli” on the website <www.yingli.com.au>, the Respondent argues that Yingli Energy (Beijing) Co., Ltd was trading as “Yingli Energy” and “Yingli Solar” (not “Yingli” on its own). Therefore, there would be no confusion in the marketplace between the Respondent’s use of the single word “Yingli” and the Complainant’s use of “Yingli Energy” and “Yingli Solar”.

The Respondent added that “Ying Li” means “for profit” in Chinese and that the word cannot therefore be registered as a trade mark unless it is used in a particular font or colour as is shown by the representation for Registered Trade Mark No. 1576255.

The Respondent also gives evidence that it registered a business name “YINGLI” on 20 November 2013.

The Respondent seeks to have the complaint dismissed. The Respondent adds that it is still willing to sell the Domain Name to Yingli Energy (Beijing) Co., Ltd for the amount of \$4,000.

5. DISCUSSION AND FINDINGS

In order to have the Domain Name transferred to it, the Complainant must make out each of the following elements under Schedule A of the auDRP:

- (a) the Domain Name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights (paragraph 4(a)(i));
- (b) the Respondent has no rights or legitimate interests in the Domain Name (paragraph 4(a)(ii)); and
- (c) the Respondent registered or subsequently used the Domain Name in bad faith (paragraph 4(a)(iii)).

The Respondent advises that its name is “SueTon Trust trading as The Twelve Volt Shop Pty Ltd”. The Domain Name is registered in the name of “The 12 Volt Shop (ABN 76159775302)”.

In order to clarify the Respondent’s correct legal entity, the Panel conducted a search of the Australian Business Register and confirms that the Respondent’s name is “Sueton Trust trading as The Twelve Volt Shop (ABN 76159775302)”.

5.1 **Paragraph 4(a)(i) of the auDRP:**

The Complainant brings this complaint on behalf of Yingli Green Energy Holding Co., Ltd. The Complainant relies on the Australian Registered Trade Mark Nos. 1278609 “YINGLI SOLAR LOGO” and 1576255 “YINGLI” as the basis of this complaint. However, the Panel notes that these Trade Marks are owned by Yingli Energy (China) Co., Ltd (and not the Complainant or Yingli Green Energy Holding Co., Ltd).

In this regard, the Complainant submitted as evidence in support a diagram of corporate structure which sets out the relationship of the entities within the Yingli Group. According to the corporate structure diagram, Yingli Green Energy Holding Co., Ltd has a wholly owned subsidiary company called Yingli Green Energy (International) Holding Co., Ltd. Yingli Green Energy (International) Holding Co., Ltd owns Yingli Energy (Beijing) Co., Ltd, Yingli Energy (China) Co. Ltd which is the owner of the Trade Mark Nos. 1278609 and 1576255, and Yingli Green Energy Capital Holding (Hong Kong) Co., Ltd which is parent company of the Complainant, which is the Australian trading entity.

The diagram of corporate structure is the only evidence provided by the Complainant to support its assertion of the relationship between the owner of the Trade Marks and the Complainant. In the absence of any other evidence such as official incorporation documents to support the corporate structure diagram being relied upon, and that the Complainant was basing this complaint only on the Registered Trade Marks, the Complainant’s eligibility to bring this complaint would have been doubtful.

The Panel took into consideration that the Respondent did not argue this submission by the Complainant and, further recognised the Complainant’s position with the Yingli Group. It also admitted having had business dealings with Yingli Energy (Beijing) Co., Ltd since mid-2010. Hence, the Panel is satisfied by the Complainant’s evidence regarding its right to bring this complaint.

The Panel then turns to the question of whether the Domain Name is identical to Trade Mark Nos. 1278609 “YINGLI SOLAR LOGO” and 1576255 “YINGLI” as alleged by the Complainant. In this regard, the Respondent asserts that the Trade Mark No. 1576255 “YINGLI” is in green and is stylised so it would not be identical or confusingly similar to the Domain Name <yingli.com.au>. Further, that the Yingli Group is actually using “Yingli Energy” and “Yingli Solar” as trading names.

The Respondent’s allegations are rejected by the Panel. The Registered Trade Mark No. 1576255 “YINGLI” constitutes a somewhat stylised word and it does not include any colour claim whatsoever. The word “Yingli” is a prominent or significant element of the Trade Mark Nos. 1278609 and 1576255 not to mention that the additional words “energy” and “solar” are merely descriptive of the services claimed in the Trade Marks, namely, batteries and solar panels etc.

The Panel therefore finds that paragraph 4(a)(i) is satisfied.

5.2 **Paragraph 4(a)(ii) of the auDRP:**

It is uncontested that the Complainant did not license or otherwise authorise the Respondent to use the word “YINGLI” for any purpose. This burden therefore shifts to Respondent to prove that it has a right to or legitimate interest in the Domain Name pursuant to Paragraph 4(c) of Schedule A of the auDRP: *Document Technologies, Inc. v. International Electronic Communications Inc* (WIPO Case No. D2000-0270).

Paragraph 4(c) of Schedule A of the auDRP sets out what is required to demonstrate the registrant’s rights to or legitimate interests in the domain name for the purpose of Paragraph 4(a)(ii):

- (i) the Registrant’s bona fide use of, or demonstrate preparations to use, the domain name in connection with an offering of goods or service (not being the offering of domain names that the registrant has acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) the Registrant (as an individual, business, or other organisation) has been commonly known by the domain name, even if the registrant has acquired no trademark or service mark rights; or
- (iii) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trade mark at issue.

The Panel finds that the mere fact of the Respondent being in the solar panel industry and selling Yingli products at its website <www.yingli.com.au> (or any other website) does not allow the Respondent to claim any rights in the Domain Name. A re-seller, even an authorised re-seller, cannot use the manufacture’s trade mark in a domain name without the express consent of the owner: *The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co. Inc.* (WIPO Case No. D2000-0113); *Avon Products, Inc. v. Jongsoo Lee* (WIPO Case No. D2001-0272). Such authorised consent does not exist in this matter.

Moreover, the fact that the Respondent holds the Business Name Registration “YINGLI” does not add to any right because a business name registration does not confer any legal right to use a name or trade mark. This is particularly so when considering that the Business Name was registered by the Respondent after being made aware of a dispute regarding the Domain Name.

The Respondent has failed to demonstrate its right or legitimate interests in or to the Domain Name. The Panel therefore finds that Paragraph 4(a)(ii) has been satisfied by the Complainant.

5.3 **Paragraph 4(a)(iii) of the auDRP:**

Paragraph 4(a)(iii) of Schedule A of the auDRP requires that the Domain Name has been registered or subsequently used in bad faith.

Paragraph 4(b) of Schedule A of the auDRP sets out a non-exhaustive list of circumstances which can be taken as ‘*evidence of the registration or used of a domain name in bad faith*’. The grounds under paragraph 4(b) include:

- (i) circumstances indicating that the Respondent has registered or has acquired

- the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of the Respondent documented out-of-pocket costs directly related to the domain names; or
- (ii) the Respondent has registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or
 - (iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
 - (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location.

The Panel notes that the Domain Name was registered on 28 July 2010, whilst the Trade Mark Nos. 1278609 "YINGLI SOLAR Logo" and 1576255 "YINGLI" (which the Complainant is relying on) have been registered since 22 December 2008 and 22 August 2013 respectively. As a general rule, when a domain name is registered before any trademark rights are established, registration of the domain name is not made in bad faith since the registrant could not have contemplated the complainant's non-existent rights: *General Growth Properties, Inc., Provo Mall L.L.C. v. Steven Rasmussen/Provo Towne Centre Online* (WIPO Case No. D2003-0845).

However, when a respondent is aware of the complainant, and it is clear that the aim of the registration was to take advantage of the confusion between the domain name and any potential rights of the complainant, bad faith can be found: *Kangwon Land, Inc. v. Bong Woo Chun (K.W.L. Inc)* (WIPO Case No. D2003-0320); *Madrid 2012, S.A. v. Scott Martin-MadridMan Websites* (WIPO Case No. D2003-0598); *General Growth Properties, Inc., Provo Mall L.L.C. v. Steven Rasmussen/Provo Towne Center Online* (WIPO Case No. D2003-0845).

In the Response, the Respondent confirmed its knowledge of the Yingli Group before it registered the Domain Name stating:

"At the time when we purchased the web site www.yinli.com.au we were hopeful of becoming the Australian distributor for Yingli solar modules."

The Respondent's awareness of the Yingli Group is also evidenced by the invoice issued by Yingli Energy (Beijing) Co., Ltd to Arrid Australia dated 27 July 2010 (being one day before the Respondent registered the Domain Name). In the Response, the Respondent confirmed that Arrid is the Respondent's company.

The Panel must then consider whether the Domain Name was registered primarily for the purpose of selling or renting it for valuable consideration in excess of its out-of-pocket costs directly related to the Domain Name (Paragraph 4(b)(i) of Schedule A of the auDRP). The Panel's determination of whether "*bad faith*" occurred in this case turns to the correspondence between the parties regarding transferring the Domain Name to the Complainant.

On 2 September 2013, Mr Cole of the Complainant sent an email to Ms Godfrey of the Respondent offering the Domain Name for the sale in the amount of \$500.00. In response to this email, Ms Godfrey states:

"I am prepared to sell the domain name, but your price is too low. We have been dealing with Yingli Green energy for a number of years and have purchased the domain name to help with our marketing of the product. We would be looking at a price of \$4,000".

In her next email to Mr Cole on 4 September 2013, Ms Godfrey states:

"To us it is worth more than the \$4,000 that we are asking. This is a special price, and we are only considering selling because we would like to be amicable. For anyone else we would not sell at any price. As you know, it is all about the web these days, and we will have to move our business more in this direction."

Although, the cost of \$4,000 is *prima facie* in excess of the Respondent's out-of-pocket costs of registering the Domain Name, the Respondent's statements suggest that the Domain Name was not registered *primarily* for the purpose of selling or renting but for marketing its business. It is worth noting that the Respondent does in fact appear on the evidence submitted to be using the Domain Name to generate traffic to a number of websites.

Hence, the Panel finds that Paragraph 4(b)(iv) of Schedule A of the auDRP applies in this matter. In this regard, the Panel refers to the Respondent's statements in the Response, namely:

"the name was quite valuable as an aid to direct people to our web page to sell the Yingli Green energy Modules."

"The domain name has been used to sell the product by directing traffic to the website for The Twelve Volt Shop, The 12 Volt Shop, 12 Volt Shop, 12 V or other web sites to sell the Yingli Solar modules in Australia".

"At the time when we purchased the web site www.yingli.com.au we were hopeful of becoming the Australian distributor for Yingli solar modules. The domain name was initially directed to our sites, including The 12 Volt Shop. ... Even though we were not the Australian distributor and the solar market was so different, we decided set up a new web site where the Yingli Solar module was the only module being represented."

These admissions coupled with the Respondent's misrepresentation that it is trading as "Yingli" at <www.yingli.com.au> when the Complainant has confirmed that the Respondent has no sponsorship, affiliation or endorsement with it, is sufficient for the Panel to find that Paragraph 4(b)(iv) of Schedule A of the auDRP has been met.

The Panel therefore finds that the Domain Name has been registered or subsequently used in bad faith and the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the auDRP.

6. DECISION

I find that the Complainant has made out all of the elements of paragraph 4(a) of the auDRP.

Accordingly, the Domain Name <yingli.com.au> is to be transferred by the Registrar, AussieHQ to Yingli Energy (China) Co., Ltd which is eligible to hold the Domain Name by virtue of its Australian Registered Trade Mark Nos. 1278609 and 1576255 under the *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs*.

Sara Delpopolo
Sole Panelist

30 May 2014